

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 8

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MICHAEL E. ORLOWSKI

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Appeal No. 96-1823  
Application No. 08/187,521<sup>1</sup>

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ON BRIEF

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Before CALVERT, Administrative Patent Judge, McCANDLISH, Senior Administrative Patent Judge and NASE, Administrative Patent Judge.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 6, which are all of the claims pending in this application.

We REVERSE.

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<sup>1</sup> Application for patent filed January 28, 1994.

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BACKGROUND

The appellant's invention relates to a putter having vibration damping material in the shaft. Claims 1 and 5 are representative of the subject matter on appeal and a copy of those claims, as they appear in the appendix to the examiner's answer, is attached to this decision.

The prior art references of record relied upon by the examiner as evidence of obviousness under 35 U.S.C. § 103 are:

Bills, Jr. (Bills)	3,083,969	Apr. 2, 1963
Okumoto et al. (Okumoto)	5,007,643	Apr. 16, 1991
Fry (United Kingdom)	2,200,560	Aug. 10, 1988

Claims 1 through 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bills in view of Fry and Okumoto.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the § 103 rejection, we make reference to the examiner's answer (Paper No. 7, mailed March 16, 1995) for the examiner's complete reasoning in support

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of the rejection, and to the appellant's brief (Paper No. 6, filed February 13, 1995) for the appellant's arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to claims 1 through 6. Accordingly, we will not sustain the examiner's rejection of claims 1 through 6 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill

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in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, e.g., Grain Processing

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Corp. v. American Maize-Products Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

With this as background, we analyze the examiner's rejection of independent claims 1 and 6 based on 35 U.S.C. § 103 as being unpatentable over Bills in view of Fry and Okumoto.

In the rejection (answer, pp. 3-4), the examiner determined that: (1) Bills uses a foamed plastic material to reduce unwanted vibration, thus improving the feel of the club head; (2) Bills differs from the claimed invention in that Bills does not disclose a filling comprising an epoxy resin and microballoons; (3) Okumoto shows it to be old in the golf art to use an epoxy resin and microballoon mixture to replace a foam material conventionally used in clubs since the mixture increases the fracture strength of the club head; and (4) Fry discloses a filler material in a putter that is used to selectively weight either the head or shaft in order to improve the feel of the club. The examiner then determined that it would have been obvious to one skilled in the art to modify Bills by replacing the foam used in the shaft portion with a resin and microballoon mixture as taught by Okumoto since Fry would have motivated the

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skilled artisan to extend and apply the teachings of Okumoto, which is concerned with club head feel, to Bills, which is concerned with shaft feel.

Our review of Bills, Fry and Okumoto reveals that the teachings therein would not have rendered the claimed subject matter obvious to one of ordinary skill in the relevant art at the time of the appellant's invention. In that regard, we see no teaching in the applied prior art that would have suggested either of the following limitations: (1) a rigid filling replacing the air within the putter shaft, wherein the rigid filling comprises an epoxy resin filled with microballoons, as recited in claim 1, or (2) injecting the microballoon filled liquid epoxy resin into the handle end of the putter shaft and then permitting the epoxy resin to cure within the putter shaft as recited in claim 5. We agree with the appellant's argument (brief, p. 4) that the complete filling of Bills' shaft with the epoxy resin and microballoon mixture of Okumoto would destroy the normal sort of shaft flex that Bills teaches to provide in his club shaft. Thus, it would not have been obvious to one of ordinary skill in the art at the time of the appellant's invention to completely fill Bills' shaft with Okumoto's mixture.

Furthermore, while the epoxy resin and microballoon mixture is known as taught by Okumoto, this by itself or in combination with Bills and Fry is not sufficient, in our opinion, to render obvious either of the limitations mentioned above. That is, we see no motivation of why one skilled in the art would have used Okumoto's mixture to break the hollow interior of Bills' shaft into distinct cells to disrupt the pressure waves instead of the foam taught by Bills.<sup>2</sup> Thus, it appears to us that the examiner has engaged in a hindsight reconstruction of the claimed invention. This, of course, is impermissible.<sup>3</sup> Since all the limitations of independent claims 1 and 5 are not taught or suggested by the applied prior art, the examiner has failed to meet the initial burden of presenting a prima facie case of obviousness.<sup>4</sup> Thus, we cannot sustain the examiner's rejection of appealed claims 1 and 5, or claims 2 through 4 and 6 which

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<sup>2</sup> Bills teaches (column 2, lines 12-21) that a very small quantity of foamed plastic material is included in the hollow interior of the shaft to break the interior of the shaft into distinct cells or pockets to disrupt pressure waves that tend to develop in the air cavity within the shaft.

<sup>3</sup> In re Fine, supra; In re Warner, supra.

<sup>4</sup> Note In re Rijckaert, supra; In re Lintner, supra; and In re Fine, supra.

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depend therefrom, under 35 U.S.C. § 103 as being unpatentable  
over Bills in view of Fry and Okumoto.



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CONCLUSION

To summarize, the decision of the examiner to reject claims  
1 through 6 under 35 U.S.C. § 103 is reversed.

REVERSED

IAN A. CALVERT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
HARRISON E. McCANDLISH, Senior	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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APPENDIX

1. An improved putter of the type having a hollow shaft with a handle at one end and a putter head at the other end and having a volume of air within the interior of said putter shaft, wherein the improvement comprises:

a rigid filling replacing the air within said putter shaft, said rigid filling comprising an epoxy resin filled with microballoons, said filling being bonded to the interior of said shaft.

5. A process for improving the feel of a putter having a hollow shaft with a handle at one end and a putter head at the other end comprising the steps of:

mixing a liquid epoxy resin with a hardener and at least 35 percent by weight of microballoons to provide a microballoon filled with epoxy resin;

injecting said microballoon filled liquid epoxy resin into the handle end of the putter shaft; and

permitting the epoxy resin to cure within said putter shaft.

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APJ NASE

APJ CALVERT

APJ McCANDLISH

DECISION: **REVERSED**

Prepared By: Delores A. Lowe

**DRAFT TYPED:** 17 Nov 97

**FINAL TYPED:**